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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,394	12/21/2001	Edward Michael Silver	36968-263531	1038

23552 7590 06/07/2004
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EXAMINER

SINGH, RAMNANDAN P

ART UNIT PAPER NUMBER

2644

DATE MAILED: 06/07/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,394

Applicant(s)

SILVER ET AL.

Examiner

Ramnandan Singh

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4412-8-04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2644

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 22 march 2004 have been considered but are moot in view of the new ground(s) of rejection.

2. **Status of Claims**

Claims 1, 4, 6-10, 18, 26 and 36 are amended.

Claims 1-28 are pending.

3. **Change of Scope**

With the amendment to the claims, a new search for prior art is necessitated. Also, the new ground(s) of rejection are made.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 9, 13, 18, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Holt et al [US 20030118160 A1].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Holt et al teach a system for monitoring a call forwarded (i.e. **directed**) to a network-based voice mail system (VMS) shown in Fig. 2, comprising:

a central office switch (CO) (104) connected to the VMS (108) and customer premises equipment (118) associated with a called party, the CO operative to receive a call to a called party number, forward the call to the VMS, receive a call monitoring signal from the VMS (108), and to send an activate call to monitoring alert to the CPE associated with the called party. In essence, Holt et al teach a capability for a subscriber to monitor messages as they are being recorded and the capability to intervene [Para. 0008; Fig. 2; Para. 0021; 0023; 0026; 0028; 0030; 0033].

Claim 13 is essentially similar to claim 1 except for determining whether the call can be monitored. Holt et al teach application server 206 that may first query whether or not the subscriber is available to monitor the calls [Fig. 3A; Para. 0030].

Claim 18 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Claim 30 is essentially similar to Claim 1 except for a speaker assembly, wherein the speaker assembly for monitoring a call is an inherent feature of a telephone answering system. For example, Manicone [US 5,748,718] shows a telephone monitoring system having a speaker which is connected to audibly monitor a call on a telephone line [col. 4, lines 47-65].

Regarding claims 6 and 9, the limitations are shown above.

6. Claims 1, 3-6, 9, 13, 18, 23, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo et al [US 4,811,381].

Regarding claim 1, Woo et al teach a method for monitoring a call forwarded to a network based voice mail system (VMS) shown in Fig. 1, comprising:

a central Office switch (CO) 22 connected to the VMS 32 and customer premises equipment, receiving a call forwarded to the VMS 32 with a called party

number from a central Office switch 22 [col. 2, lines 40-47; col. 3, lines 45-59; col. 4, lines 20-32; Abstract] and ;

the VMS operative to send the call monitoring provisioned signal to the CO [col. 4, lines 21-32].

Claims 13 and 18 are essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Claim 30 is essentially similar to Claim 1 except for a speaker assembly, wherein the speaker assembly for monitoring a call is an inherent feature of a telephone answering system. For example, Manicone [US 5,748,718] shows a telephone monitoring system having a speaker which is connected to audibly monitor a call on a telephone line [col. 4, lines 47-65].

Regarding claims 3-5, Woo et al further teach sending a start of greeting signal from the VMS 32 [Figs. 1, 7; col. 2, lines 48-53; col. 3, lines 52-59]; playing a voice message greeting associated with the called a party number [col. 10, lines 40-47; Abstract]; and sending an end of greeting signal [col. 4, lines 53-63].

Regarding claims 6, 9, and 23 , the limitations are shown above.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al [US 4,811,381] in view of Muller [US 6,295,341 B1].

Regarding claim 26, Woo et al teach a method for monitoring a call forwarded to a network based voice mail system (VMS) shown in Fig. 1, comprising:

receiving a call forwarded to the VMS 32 with a called party number from a central Office switch 22 [col. 2, lines 40-47; col. 3, lines 45-59; col. 4, lines 20-32; Abstract];

sending a start of greeting signal from the VMS 32 [Figs. 1, 7; col. 2, lines 48-53; col. 3, lines 52-59];

playing a voice message greeting associated with the called a party number [col. 10, lines 40-47; Abstract]; and

sending an end of greeting signal [col. 4, lines 53-63].

Woo et al do not teach a voice mail box.

Muller teaches a VMS 6 with a mailbox 12 shown in Fig. 1[col. 3, lines 24-37; col. 2, lines 11-45].

Woo et al and Muller are analogous art because they are from a similar problem solving area, viz. , a network-based voice mail system (VMS).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a mail box associated with a particular subscriber to record an incoming call and conferences [Muller; col. 2, lines 11-24].

Regarding Claim 27, Muller teaches using a voice mail code to access a mail box 12 [col. 2, lines 25-45; col. 3, line 40 to col. 4, line 3; col. 4, lines 50-59].

Regarding Claim 28, Muller uses a number of keys to enter a PIN code to access a mail box 12 [Fig. 2; col. 1, line 66 to col. 2, line 9; col. 7, lines 54-60]. This inherently transmits the code using a DTMF signal.

Regarding Claim 29, Muller teaches that the remote answering device 2 send a few bits of data to the network-based voice-mail system 6 via local service provider 4, as shown in Fig. 1, before disconnecting the line [col. 7, lines 34-37].

9. Claims 10-12, 14-15, 22, 25, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to claims 1, 9, 13, 18, 30 above, and further in view of Gardell et al [US 6,011,896].

Regarding claim 10, Woo et al do not teach an intercept tone.

Gardell et al teach a voice mail intercept service terminal (VMIST) 340 for receiving an intercept tone from the customer's telephone 310; and causing the called party to be connected to a calling party [col. 7, lines 9-33].

Woo et al and Gardell et al are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the method of sending an intercept tone to the CO for the voice mail service to create a three-party call [Gardell et al; col. 7, lines 24-28].

Regarding Claims 12, 22, 25, 34, 36-37, see Figs. 6A and 6B [Gardell et al].

Regarding Claim 11, Gardell et al teaches generating DTMF signal by pressing keys used for generating intercept signals and other commands [col. 5, lines 57-63].

Claim 35 is essentially similar to Claim 11 and is rejected for the reasons stated above apropos of Claim 11.

Regarding Claim 14, Gardell et al teaches prompting the subscriber at the telephone device 210 to enter a password, and authenticate the password [col. 5, line 50 to col. 6, line 22].

Claim 38 is essentially similar to Claim 14 and is rejected for the reasons stated above apropos of Claim 14.

Regarding Claim 15, the voice mail code (i.e. password) is transmitted , e.g. , as DTMF signals [col. 5, lines 57-63].

10. Claims 14-17, 21, 24, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to claims 13, 18, 30 above, and further in view of Rogers et al [US 5,946,386].

Regarding claim 14, Woo et al do not teach expressly detecting a voice mail code.

Rogers et al teaches identifying a called a party 111 or 113 through the digits entered (i.e. code), through voice recognition or otherwise [col. 11, lines 21-43].

Woo et al and Rogers et al are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the method of detecting the voice mail code of Rogers et al with Woo et al to identify the called party [Rogers et al; col. 11, lines 33-39].

Regarding claim 15, Rogers et al teach a DTMF sequence to identify an incoming call [col. 11, lines 47-50].

Regarding Claim 16, when a user receives a **new** voice-mail message, the Call Management System is notified [Rogers et al; col. 28, lines 55-67].

Regarding Claim 17, a call management computer intercepts a telephone call wherein the incoming call type signal having specified DTMF is also determined [Rogers et al; col. 6, lines 55-59; col. 11, lines 44-50].

Claim 24 is essentially similar to Claim 17 and is rejected for the reasons stated above apropos of Claim 17.

Regarding Claims 31-32, Rogers et al generating a distinctive ringing sound to alert a user [Rogers et al; col. 3, lines 53-65].

Claim 21 is essentially similar to Claim 32 and is rejected for the reasons stated above.

11. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to Claim 30 above, and further, in view of Manicone [US 5,748,718].

Regarding Claim 33, Woo et al does not teach alerting a user using a visual indicator.

Manicone teaches applying a speaker and **display** (i.e. visual) monitor which is connected to audibly and visually monitor signals on the telephone line in the premises when the manually actuatable switch is actuated [col. 4, lines 47-65; col. 2, line 59 to col. 3, line 18].

Woo et al and Manicone are analogous art because they are from a similar problem solving area, viz. , telephone monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the visual indicator of Manicone to the Woo's call monitoring system to provide detection and visual indication of incoming telephone calls [Manicone; col. 1, lines 14-21].

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to Claim 6 above, and further, in view of Manicone [US 5,748,718].

Regarding Claim 8, Woo et al does not teach alerting a user using a visual indicator.

Manicone teaches applying a speaker and **display** (i.e. visual) monitor which is connected to audibly and visually monitor signals on the telephone line in the premises when the manually actuatable switch is actuated [col. 4, lines 47-65; col. 2, line 59 to col. 3, line 18].

Woo et al and Manicone are analogous art because they are from a similar problem solving area, viz. , telephone monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the visual indicator of Manicone to the Woo's call monitoring system to provide detection and visual indication of incoming telephone calls [Manicone; col. 1, lines 14-21].

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to Claim 6 above, and further, in view of Rogers et al [US 5,946,386].

Regarding Claim 7, Woo et al do not teach that each CPE generate a distinctive sound.

Rogers et al teach generating a distinctive ringing sound to alert a user [col. 3, lines 53-65].

Woo et al and Rogers et al are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the distinctive sound generation of Rogers et al to the Woo's call monitoring system to alert a particular user [Rogers et al; col. 3, lines 61-63].

14. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al as applied to Claim 18 above, and further, in view of Muller [US 6,295,341 B1].

Regarding Claims 19-20, Woo et al does not teach generating a greeting sound.

Muller teaches playing a greeting sound for the caller while monitoring is in process [col. 2, lines 46-65; col. 4, lines 1-25; col. 6, line 61 to col. 7, line 3; col. 7, lines 41-53].

Woo et al and Muller are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the technique of a greeting by Muller to the Woo's call monitoring system to alert a particular user.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (703)308-6270. The examiner can normally be reached on M-F(8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester Isen can be reached on (703)-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2644

A handwritten signature in black ink, appearing to read 'R Singh', is located to the right of the printed name and title.